

THE JOINT EXAMINATION BOARD

**PAPER D&C
DESIGN AND COPYRIGHT
2003**

COMMENTS

GENERAL

There was widespread evidence of bad exam technique resulting in time pressure, which really should not happen. A particular fault was querying facts given in the question or in making redundant remarks. Examples were in question 3a where there were lengthy discussions as to whether design right existed when the question had said that it did, in question 5 as to whether copyright existed when the question said it did and in question 10 where qualification is completely irrelevant to registered designs, especially when the client is from the UK.

INDIVIDUAL

QUESTION 1.

With respect to the United Kingdom:-

- (a) What is a “licence of right”?
(1 mark)
- (b) In what circumstances, in relation to (i) unregistered design right and (ii) United Kingdom registered designs, are licences of right available?
(3 marks)
- (c) Who settles the terms of a licence of right for design right?
(2 marks)
- (d) If licences of right are available, what advantage does this give your client if they are threatened with a United Kingdom unregistered design right infringement action?
(2 marks)
- (e) In what circumstances might a licence not be binding on the successor in title to a United Kingdom unregistered design right?
(2 marks)

ANSWERS

- (a) a (statutory) entitlement for a third party to exploit a right on terms acceptable to the owner of the right
- (b) (i) Last 5 years of term: S. 237. (ii) No specific provisions.
- (c) The parties, else the Comptroller, else the registered design Appeal Tribunal (S.237(2), S.247(1); S.249)
- (d) No injunction/order for delivery up; limitation on damages (S.239)
- (e) Purchaser in good faith for valuable consideration without notice, or their successor – S.222(4)

COMMENTS

- 1a Too many people defined a licence rather than a licence of right;
- 1c For full marks mention the possibility of appeal to the registered design Appeal Tribunal was required;
- 1e The Examiners were looking for knowledge of the provisions of s222 CDPA; very few candidates obliged, although some showed knowledge of the general principles.

QUESTION 2.

United Kingdom Design Registration No. 2222222 was filed on 2nd December 1992 in respect of “a chair”.

- (a) What was the first renewal date if it has no claim to Convention priority?
(1 mark)
- (b) What would have been the first renewal date if the design had claimed priority from a French registration filed on 3rd June 1992?
(2 marks)
- (c) For the case where the Design Registration was filed on 2nd December 1992; the proprietor, a sole manufacturer/trader was in hospital for a few months during 2002 with a sudden illness. In that period, his secretary received the official renewal reminder but failed to understand its significance and ignored it, as the renewal date was recorded in the proprietor’s personal diary which was inaccessible to the secretary during his illness. What can the proprietor do to effect the renewal:-

(i) If the failure to pay was discovered in May 2003?
(1 mark)

(ii) If the failure to pay was discovered in October 2003?
(3 marks)

(d) The proprietor has discovered a rival manufacturer selling settees made to the identical design. Assuming that renewal had been allowed under (c) (ii) above, what limits, if any, are placed on the proprietor to take action for infringement?

(3 marks)

ANSWER

- (a) 03/12/07
- (b) 03/12/07 (RD Reg. 2001, Regs. 12(6) and (7)).
- (c) (i) Renewal as of right under S. 8(4) + late fee.
(ii) Renewal at Registrars' discretion under S.8A. Need to show "reasonable care".
- (d) S.8B.

COMMENTS

- 2b The date is before the change made by Design Regulations 2001 so renewal fell on the anniversary of the priority date
- 2d This was badly answered with many candidates showing little or no knowledge of the intervening right provisions. Very few discussed whether chair vs. settee was an issue

QUESTION 3.

- (a) Your client, Mrs. Anderson, is a Belfast based designer and manufacturer of knitwear. Two years ago she brought out a new design of jumper. When on holiday recently in Scotland, Mrs. Anderson noticed a very similar jumper design on sale in a local shop. On making discreet enquiries, she discovered that the Scottish jumpers are made and sold locally by a manufacturer whose design director attended the same fashion college as her 20 years ago. The Scottish designs were first marketed a year after hers.
Discuss whether there is a likelihood of infringement of Mrs. Anderson's design right by the Scottish design. Assume that design right subsists in Mrs. Anderson's design.

(3 marks)

- (b) Your client, Mr. Bennett, manufactures and sells reproduction fire surrounds based on designs for cast iron originals taken from Victorian foundry pattern books. Many of these surrounds can still be seen in Victorian houses today. The products are made of fibreglass reinforced plastics for cheapness and ease of installation, being aimed at the D-I-Y, as well as new-build, markets. The designs sold “mix-and-match” various features of different designs from the pattern books. Mr. Bennett has come to you for advice after discovering that a disgruntled ex-employee has set up a competing business selling identical product-for-product fireplace designs, as well as others based on different combinations of features from the same pattern books. Would Mr. Bennett be able to take action for United Kingdom unregistered design right infringement against his ex-employee? Give your reasons.

(7 marks)

ANSWER

- (a) Need to show copying – burden of proof can shift to defendant if objective similarity and opportunity to copy exists. The latter appears absent on the facts, unless A’s designs originated from her college days and the Scottish design director remembered them. Could it, instead, be a case of parallel development, arising from both designers’ similar training?
- (b) Scholes Windows – need to construe design field. Can include old designs still prevalent today, especially if B’s designs are intended to imitate these. B’s designs are not straight copies from the pattern books, but does the mixing and matching involve sufficient skill, judgement, “sweat-of-the-brow” for originality in the copyright sense? If original, are the designs nonetheless commonplace? E.g. Ocular Sciences and Laddie J’s comment that a striking new combination can be made from a collection of known design features. Depending on these facts, B’s designs may be original and not commonplace, so that UDR subsists and the product-for-product competing copies would infringe. The different combinations may not be actionable, if either none of

the designs are original/not commonplace, or if the competing designs are original/not commonplace but the different combinations of features in the competing fire surrounds mean that these are not copied exactly or substantially to B's design.

COMMENTS

3a As mentioned above too many candidates wasted time, and confused themselves, by asking whether Mrs A had UDR. They were told she had, which settles the questions whether the new jumper was commonplace and whether she had somehow already designed it at college 20 years ago!

Causal links were much mentioned with the common training often being cited as a possible indicator of infringement. If anything it tends in the other direction

3b This was obviously a complex question, as could be seen from the marks available. Failure to read it properly led to disaster, with "mix and match" causing too many people to start long dissertations on "must fit/must match", which is irrelevant. Mr B's surrounds are made by mixing features of the old designs; they are clearly original and are probably susceptible of UDR.

Very few distinguished the situations where the ex-employee copied exactly and where he re-selected.

QUESTION 4.

Explain the main differences between Community Registered Designs and Community Unregistered Designs as to:-

(a) Subsistence (4 marks)

(b) Term (3 marks)

(c) Infringement (3 marks)

ANSWER

(i) No need to file for UCD protection: arises when the design has been made available to the public; cf. need to file for RCD protection - CDR Art. 2. Date

of first making available to the public replaces the filing/priority date for determining novelty/individual character of UCD's cf. RCD's – CDR, Arts. 5 & 6. NB definition of making available to the public – CDR, Arts. 7 & 11(2).

(ii) CDR Arts. 11 & 12

(iii) CDR Art. 19(2) – need for infringement of UCD to result from copying.

COMMENTS

4a There was lack of precision as to the conditions under which CDR comes into existence, and almost no-one pointed out the different dates at which novelty/individual character have to be assessed as between CDR and CDR. Discussion of “making available to the public” was often incomplete or inaccurate.

QUESTION 5.

Your client, a copyright owner, tells you that he has very recently seen objects for sale which are clearly intended to be identical works to his but which are counterfeit. He has seen them for sale in a shop and from a stall in a street market. Explain in detail what legal remedies, if any, are available to him under the Copyright, Designs and Patents Act 1988 against the respective vendors.

(10 marks)

ANSWER

Shop :-

Letter before action;
delivery up/destruction;
damages;
source of copies;
undertakings for future;
Ex-parte interlocutory application;
same relief except undertaking;
cross-undertaking in damages.

Street (if not a permanent place of business):-

Seizure provisions S. 100 CDPA;

Notice to police;

No force;

Leave statutory notice at site.

COMMENTS

Clearly the Examiners were looking for contrasts being drawn between the two vendors' situations. Although it is arguable whether the market stall is or is not a regular place of business, it is plain bad exam technique, whatever the conclusion reached, not to demonstrate that you know what the Examiner obviously wants you to demonstrate.

Very few showed that the shopkeeper is not an infringer unless with knowledge etc; it not a matter of non-liability to damages. However the state of knowledge of the stallholder does not affect whether the seizure provisions may properly be invoked.

For full marks, an answer should have pointed out that at least in theory all normal sanctions (damages etc) would be available against both vendors if infringers.

QUESTION 6.

(a) What are the advantages of filing a multiple Community design application?

(2 marks)

(b) What restriction(s) are there on the kinds of designs that can be included in a multiple Community design application?

(1 mark)

(c) What is the maximum number of views of a design that can be contained in a Community design registration?

(1 mark)

(d) By what means may Community design applications be transmitted to OHIM for filing? Give the advantages or disadvantages for each means.

(6 marks)

ANSWER

(i) Lower official fees. Administrative convenience (although dealings in the various designs, including renewals, can be independent, and it may therefore be necessary to establish individual case records).

(ii) Same Locarno class, other than for ornamentation: CDR Art. 37(1)

- (iii) 7: CDIR Art. 4(2)
- (iv) Mail/courier to OHIM. Both not instantaneous. Mail slower and less reliable of the two.

Hand filing via UKPO. Convenient and secure if your office is within easy reach of London or Newport filing facilities. Same day filing date. Extra £15 handling fee competitive with courier cost.

Electronic filing. Same day filing date and confirmation of receipt (subject to doubts as to reliability of technology). Restriction on maximum file size for representations, therefore potentially lower fidelity than the above methods, but probably acceptable in most cases.

Fax filing. Same day transmission, but no guarantee of complete and intelligible receipt. Fine detail in representations will inevitably be obscured. This could have dire consequences for the filing date accorded and/or the protection eventually secured. Fax filing is therefore best avoided but if used should be followed up with a mail/courier confirmation copy within a month (preferably despatched the same day).

Hand filing at OHIM. Generally inconvenient for UK firms.

- (v) Dotted lines (excluded parts); boundaries (around included parts); colouring (of included parts on otherwise black-and-white drawings): Examination Guidelines, para. 11.4).

COMMENTS

- (d) The marks distribution showed the complexity and importance of this part of the question, but regrettably few candidates showed themselves capable of a clear analysis of the possibilities and their respective advantages. For this sort of question a tabular approach would probably help.

Remarkably few candidates mentioned the surest mode of all for London-based people namely hand-filing at the UKPO filing office.

QUESTION 7.

In relation to United Kingdom registered design applications:

- (a) When may it be unnecessary (or undesirable) to show all features of a design?
(2 marks)
- (b) In what circumstances may a divisional application be called for?
(2 marks)
- (c) What is the time limit for filing a divisional design application?
(2 marks)
- (d) How would you show a design consisting of a repeating surface pattern in the representations filed at the Designs Registry?
(2 marks)
- (e) When are registrations relating to textiles published? When are registrations relating to wallpaper or lace published?
(2 marks)

ANSWER

- (a) Disclaimed features; features not critical in determining individual character.
- (b) When the application contains more than one design, e.g. when the representations show more than one product and the Registry determine that the products embody different designs.
- (c) 12 months from parent filing date, extendable to 15 months with (monthly) fees: Rule 36.
- (d) ‘Each representation or specimen of a design which consists of a repeating surface pattern shall show the complete pattern and a sufficient portion of the repeat in length and width’: rule 23.
- (e) 3 years and 2 years from registration, respectively.

COMMENTS

- (d) It is insufficient to say that the design must show the design sufficiently; that is a truism. See Rule 23(2).

QUESTION 8.

With respect to the following circumstances, who has a cause of action under subsisting copyright and/or design right and, if they have, against whom? Unless otherwise stated all events occur in the United Kingdom. Explain your answer for each circumstance.

(a) The subject of a family photograph when a photographer from whom the photograph was commissioned passed the copy to a newspaper, which publishes it.

(2 marks)

(b) The sculptor of an original and unique statue who finds that copies are being mass-produced in Taiwan with some being imported into and sold in the United Kingdom. The copies are crude and do not do justice to the original.

(3 marks)

(c) The employer of a draughtsman who in the course of employment used the employer's computer-aided design programmes to produce drawings for a set of cutlery. The cutlery is now on sale. The draughtsman has taken copies and has purported to license a competitor to use them for manufacturing.

(5 marks)

ANSWERS

(a) Commissioner is not owner so copying by photographer not infringement. Passing to newspaper as such is not contrary to S.85, but publication is.

(b) Sculptor is owner. Copying in Taiwan not right of UK copyright. Importation is infringement of copyright of artist's work (S.4 (1)(a) by virtue of S.22. Otherwise sale under S.23(b) or possession, S.23(a), but only if there is knowledge or belief in each case. Also possibly, as author, right to object under S.80(4)(a) to "derogatory treatment".

(c) Copyright in drawings. Owner is employer: S. 11(2). Copying by employee for himself is infringement: S.16(1)(a) + 17(1). Copying in 3D by third party not infringement by virtue of S.51(1).

Design right. Owner is employer: S.215(3). Competitor would infringe if articles made: S.226(1). Making further copies of design doc. S.226(2) is not infringement: S.236. Purporting to authorise is also infringement: S.226(3).

COMMENTS

- (a) Though many people recognized that copyright remained with the photographer while there was a moral right in the commissioner they failed to apply this. If the photographer is the owner, he can copy. The right to which s85 is directed is publication, which is what the newspaper did.
- (c) Important to separate copyright and design registration considerations since the situations arising under them are quite different. However the employer is clearly the owner of both. Copying by employee is infringement of copyright, while 3D manufacture by competitor is not. The employee infringes design registration by purporting to authorize (s226(3) CDPA) and the competitor if they manufacture

QUESTION 9.

Who is the first owner of United Kingdom unregistered design right in the following circumstances?

- (a) a design created by a designer who is an employee of a third party in pursuance of a commission to the third party; all in United Kingdom.
(3 marks)
- (b) the designer and manufacturer are Japanese and articles to the design are imported into the EU by a German firm as exclusive licensee for the whole of the EU.
(5 marks)
- (c) the design is computer-generated (in United Kingdom).
(2 marks)

ANSWER

- (a) The commissioner: S.215(2) and (3) CDPA
- (b) The German firm if first marketer: S.215(4) +220(1) and (4). Right to enforce: S234(1)
- (c) The designer: S214(2) and 215(1)

COMMENTS

- (a) People who did not read the question got it wrong; the commission was to the employer
- (b) Rights arise by virtue of first marketing only if the party has the power to enforce (s234(1) CDPA). Marks were lost for failing to point this out, even

though it is a consequence of the exclusivity of the licence. There was often a lack of detail or error over who must give the exclusive authorisation, where the first marketing must take place and the territory in which the exclusive authorisation must apply.

The right belongs to the first marketer and not, as a surprising number of candidates believed, to the non-qualified original designer.

- (c) The proper answer is the designer; then that the person who made the arrangements etc is deemed to be the designer.

QUESTION 10.

A United Kingdom client has heard that unregistered design right in the United Kingdom is free. Give notes upon which you would base advice to the client to explain why the cost of registration in the United Kingdom of his new design(s) may be worthwhile.

(10 marks)

ANSWER

Proof of date. (1 mark)

Prima facie proof of ownership (1 mark)

Proof of what the design is (1 mark)

Infringement – no need to show copying (2 marks)

Duration – 25 years, subject to renewal (2 marks)

UDR subject to licences of right in last 5 years (1 mark)

Wider range of features protected, especially e.g. textiles, colours, ornamentation, with respect to unregistered design right (1 mark)

“must match”, designs registrable, but not for unregistered design right (1 mark)

COMMENTS

Apart from the redundancies noted above, quite well answered. A certificate of Design Registration is not proof of ownership, however, as many people stated, but only prima facie evidence.

QUESTION 11.

A United Kingdom individual client wishes to have registered protection for his design but believes that there is little or no market for the product in the United Kingdom, which should sell well in USA and in Germany.

Give the possible advantages and disadvantages of available strategies for registered protection; in particular can a first application be made outside United Kingdom? Ignore any questions of copyright or trade mark protection.

(10 marks)

ANSWER

Possibilities:

- a) UK first; US, DE nationals within 6 months.
- b) UK first; US, EU within 6 months
- c) US or DE national first, the others within 6 months, or both "first" at the same time.

(S. 5 RDA still in force, but no class "relevant for defence purposes" has been notified)

- d) US or EU first, the other within 6 months or both "first" at the same time.
- e) Rely on grace periods to further delay the above US and EU first filings – BUT US grace period cannot be compounded with the priority period.

Pros & cons

- a) advantage: delay cost of national filings; time for second thoughts; initially cheaper than b).

Disadvantage – doesn't really want UK; more expensive overall

- b) advantage: more territory than a) but at greater cost.
- c) Cheaper than a) or b) but immediate commitment.
- d) More expensive than c) but greater territory.
- e) Further eases cash flow, but danger of others coming onto the market in the grace period.

COMMENTS

Candidates were asked to lay out all the possibilities, not merely to select the one they thought best. The Examiners were obviously wanting not only factual knowledge of the possibilities but asked explicitly for a demonstration of the candidate's ability to weigh up pro's and con's that arose; few candidates responded fully to this, or to the

heavy clue in the question that the order in which things are done could be important, especially as the client is an individual and cash flow may be important.

Also few even answered the direct question whether first filing abroad is permissible for a UK applicant, and if they did, mostly did so wrongly or without reasons (which gets no marks). Though s5 RDA is in force, no relevant class has been notified and so it has no effect.

QUESTION 12.

During the last six months your client, a United Kingdom bicycle manufacturer, has started applying a distinctive blue and green livery to the frames of his bicycles. He also sells bicycle pumps in the same livery, both with his bicycles and separately. The distinctive colouring has become a big selling point and he is concerned that competitors might try to copy it, since all bicycles and bicycle pumps are very much standard in shape. There is one exception here; your client's pumps and the associated fittings on the frames are shaped so that the pumps are always held in a given orientation such that the liveries match. However, the pumps are also compatible with the standard fittings on ordinary frames.

Make notes on what protection, if any, your client has or could get nationally in United Kingdom. (Do not deal with possible patent, trade mark or passing-off issues.)

(10 marks)

ANSWER

Bicycles.

Now. No unregistered design right for colour(s) Copyright in drawings, if any.

Future. Registered design for bikes within 6 months and before any competitor starts (else no grace period; (limited) prior use rights: s.7A(6)).

Pumps.

Now. As for bicycles

Future. Registered design for pumps, as for bikes. OK because pumps separate items; parts of a product are separately registrable.

Pump fittings.

Orientation = “must match”, so no unregistered design right: S. 213(3)(b)(ii) CDPA. Not “must fit” because the orientation does not relate to the function of the parts (S. 1C(2) RDA). Therefore registered design may be possible subject to whether fittings are solely functional: S. 1C(1) RDA, subject to timing as above.

COMMENTS

Once again lack of organization in analysis was evident, and resulted in poor answers. There are issues of design right and/or registered design in relation to the bike, the pump, the fittings and the livery, and various combinations of these and each should be discussed, however briefly, in turn.

The most difficulty arises when considering the “must match/must fit” exclusions, and the nature of the fittings. Note that for “must fit” to bite the fit must be for the purpose of allowing the parts to perform their function and clearly that is not the case here.